



19 MAY 2006

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In re Application of:
XU, Guolin, et al.
U.S. Application No.: 10/535,334
PCT No.: PCT/SG2003/000261
International Filing Date: 10 November 2003
Priority Date: 18 November 2002
Attorney's Docket No.: P/2778-63
For: METHOD AND SYSTEM FOR CELL
AND/OR NUCLEIC ACID
MOLECULES ISOLATION

DECISION ON PETITION UNDER
37 CFR 1.47(a)

This decision is issued in response to applicants' "Petition Under 37 CFR 1.47(a)" filed 21 March 2006. Applicant has submitted the required petition fee.

BACKGROUND

On 10 November 2003, applicants filed international application PCT/SG2003/000261. The application claimed a priority date of 18 November 2002 and designated the United States. On 03 June 2004, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 18 May 2005.

On 18 May 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 23 September 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirement (Form PCT/DO/EO/905) indicating that an executed declaration in compliance with 37 CFR 1.497 and the surcharge for filing the declaration later than thirty months after the priority date was required.

On 21 March 2006, applicants filed a response to the Notification Of Missing Requirements (with required extension fee) that included the required surcharge, a partially executed declaration document, and the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the application without the signature of inventor Dennis Lee POLLA, whom applicants argue has refused to execute the application.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the nonsigning inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the nonsigning inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Here, applicants have filed the required petition fee, and the petition expressly states the last known address of the nonsigning inventor. Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Applicants here have filed an eight-page declaration executed by eight of the nine inventors and containing an unsigned signature block for the nonsigning inventor, Dennis Lee POLLA. However, this eight-page declaration appears to be a compilation of a number of different copies of a three-page declaration; the compilation is evident from the fact that the declaration document includes two copies of page 1, four copies of page 2, and two copies of page 3. The declaration is therefore not acceptable under 37 CFR 1.497 (see MPEP § 201.03(II)(B): “Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration.”). Item (3) is therefore not satisfied.

Regarding item (4), MPEP section 409.03(d) states that “[a] copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.” The MPEP also states the following:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Here, applicants provided a statement of facts from Jacqueline WONG, with supporting documents, which includes an email from the nonsigning inventor dated 20 August 2005 in which the inventor states that he would be happy to sign the documents if a copy of these materials, as well as a copy of the US Application, was mailed to him at his U.S. permanent residence. Applicants have also provided a statement from Winnie CHU, with supporting documents, which describes the efforts made to obtain the inventor's signature after receipt of

the 20 August 2005 email. These subsequent efforts involve additional email communications to the inventor, including an email to which a copy of the application was attached. However, applicants have provided no evidence that a copy of the complete application papers, with a request for signature, was sent to the last known address of the inventor, as required by the MPEP and as specifically requested by the inventor in his 20 August 2005 email.

Before item (4) can be considered satisfied, applicants must provide the required firsthand evidence (with documentary support) demonstrating that the complete application papers and a request for signature have been delivered to the nonsigning inventor at his last known address, and that the inventor has refused to execute the application papers.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the materials required to satisfy items (3) and (4) of a grantable petition, as discussed above. No additional petition fee is required.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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